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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,419	07/02/2003	Joel R. Jaffe	47079-00212	3591
70243	7590	11/09/2007		
NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER HARPER, TRAMAR YONG	
			ART UNIT	PAPER NUMBER
			3714	
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			11/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/612,419	Applicant(s) JAFJE ET AL.	
	Examiner Tramar Harper	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,17,18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,17,18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Pre-Appeal Request***

Examiner acknowledges Pre-Brief Conference Request filed 05/25/07, in which Applicant argues the rejections of Claims 1-14 and 16-25. Applicant's arguments with respect to the rejections of Claims 1-14 and 16-25 have been fully considered and are partially persuasive. Therefore, the rejections have been withdrawn and the finality of the last office action has been withdrawn.

### ***Response to Amendment***

Examiner acknowledges receipt of amendments filed 03/26/07. The arguments set forth are addressed herein below. Claims 1, 3-14, 17-18, & 20-24 are pending, Claims 1, 3-4, 9, 18, 20-21 have been amended, and Claims 2, 15-16, 19, & 25 are canceled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3, 5, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Rose (US 2004/0137979).**

**Claim 1:** Rose discloses a wagering game that comprises of an electro-mechanical award display. The award display includes a plurality of mechanically actuated elements (Cuckoo birds and soldiers) birds movable upon a retractable and extendable position through respective doors (Figs. 6-7). The location and position of each award element indicates an associated game outcome. The elements move relative to the housing. For example, the Cuckoo bird moves toward the player in the extended viewable position and away from the player in the retracted viewable position along a path perpendicular to the panel (Fig. 6-7, ¶ 26-27). Rose discloses that the game is a secondary/bonus game associated with a primary game such as a slot machine. Rose further discloses that a secondary or bonus game is triggered once a player reaches a predetermined trigger point/condition within the base game. Rose discloses that the award indicator display can comprise of one or more multiplier indicators (birds or soldiers or both) respective of different multiplier awards. Each indicator bears indicia respective of a multiplier award (¶ 15-20, 26-27).

**Claims 3:** The bird and/or soldiers protrude from the panel of the gaming device through the associated door in an extended position and are approximately flush with the panel when in the retracted position (door closed) (Figs. 6-7).

**Claim 5:** The physical elements are arranged in a line (Figs. 6-7).

**Claim 8:** Rose discloses the physical elements are associated with respective outcomes (Figs. 6-7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Rose (US 2004/0137979).**

**Claim 4:** Rose discloses the above with respect to claim 1, but excludes the physical elements approximately flush with the panel when in the extended position and recessed to the panel when in the retracted position. Rose discloses the physical elements are relatively protruded when in the extended position and are relatively flush/recessed when in the retracted position. Applicant discloses that the physical elements can be protruded or flushed with the panel when in the extended position and can be recessed or flushed when in the retracted position (§ 21). Thus making either arrangement equivalent. Applicant has not disclosed that having the physical elements approximately flush with the panel when in the extended position and recessed to the panel when in the retracted position solves any stated problem or is for any particular purpose. Moreover, it appears that the physical elements protruded when in the extended position and flush/recessed when in the retracted position of Rose, or applicant's invention, would perform equally well because both provide the same function of causing the physical award indicator elements to reciprocate in and out relative to the game panel.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Rose such that the physical elements are approximately flush with the panel when in the extended position and are recessed to the panel when in the retracted position because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Rose.

**Claims 6-7, 9-13, 17-18, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US 2004/0137979) in view of Nordman (US 2004/0053687).**

**Claims 6-7, 9-10, 17-18, & 23-24:** Rose discloses a wagering game that comprises of an electro-mechanical award display. The award display includes a plurality of mechanically actuated elements (Cuckoo birds and soldiers) birds movable upon a retractable and extendable position through respective doors (Figs. 6-7). The location and position of each award element indicates an associated game outcome. The elements move relative to the housing. For example, the Cuckoo bird moves toward the player in the extended position and away from the player in the retracted position along a path perpendicular to the panel (Fig. 6-7, ¶ 26-27). Rose discloses that the game is a secondary/bonus game associated with a primary game such as a slot machine. Rose further discloses that a secondary or bonus game is triggered once a player reaches a predetermined trigger point/condition/combination (start bonus outcome) within the base game. Rose discloses that the award indicator display can comprise of one or more

multiplier indicators respective of different multiplier awards. Each indicator bears indicia respective of a multiplier award (§§ 15-20, 26-27).

Rose fails to explicitly disclose moving each of the award indicators in either the extended or retracted position and provide an award based on such positions. Rose clearly shows that a player is awarded an outcome when the respective symbol is in a extended position e.g. a player is also not award an award corresponding to those elements in a retracted position (see above). Rose discloses that visual indicators of prospective payouts attract players. Rose further discloses that basic games proceeded by attract features or unusual features such as bonus game and visual indicators add to the excitement and overall entertainment of the game itself (§§ 3-4). Nordman discloses a gaming apparatus that comprises of electro-mechanical award display (§§ 37). The award display includes a plurality of octopus legs movable upon a retractable and extendable position (Figs. 11 & 13-14). The location and position of each of the octopus legs indicates an associated game outcome (§§ 51). The octopus legs move relative to the housing (§§ 85-87, Figs. 11 & 13-14). Nordman discloses that the game may be a secondary game associated with a primary game such as a slot machine (§§ 37). Nordman also discloses that a secondary or bonus game is triggered once a player reaches a predetermined trigger point/condition within the base game (§§ 45). Nordman further that the game controller/processor operates the legs sequentially in between the extended position and retracted position, stops the elements in either position, provides a result based on the relative position of each leg (§§ abstract, 85-87). It would obvious to one of ordinary skill at the time of the invention to modify the

indicators of Rose with the controller sequential reciprocating indicator means of Norman to provide a more fun and exciting mechanical award display (§ 8). Such a modification would provide the player a means to anticipate the possible different awards (some better than others) (§ 9). The reciprocating randomness of the award indicators will increase player anticipation and overall fun.

**Claims 11 & 20:** Rose discloses the birds and/or soldiers protrude from the panel of the gaming device through the associated door in an extended position and are approximately flush with the panel when in the retracted position (door closed) (Figs. 6-7).

**Claims 13 & 22:** Rose illustrates the physical elements arranged in a line (Figs. 6-7).

**Claims 12 & 21:** Rose in view of Nordman discloses the above with respect to the independent claims, but excludes the physical elements approximately flush with the panel when in the extended position and recessed to the panel when in the retracted position. Rose discloses the physical elements are relatively protruded when in the extended position and are relatively flush/recessed when in the retracted position.

Applicant discloses that the physical elements can be protruded or flushed with the panel when in the extended position and can be recessed or flushed when in the retracted position (§ 21). Thus making either arrangement equivalent. Applicant has not disclosed that having the physical elements approximately flush with the panel when in the extended position and recessed to the panel when in the retracted position solves any stated problem or is for any particular purpose. Moreover, it appears that the physical elements protruded when in the extended position and flush/recessed when in



the retracted position of Rose in view Nordman, or applicant's invention, would perform equally well because both provide the same function of causing the physical award indicator elements to reciprocate in and out relative to the game panel.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Rose in view of Nordman such that the physical elements are approximately flush with the panel when in the extended position and are recessed to the panel when in the retracted position because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Rose in view of Nordman.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-14, 17-18, & 20-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

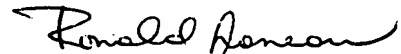
**Gordon (US 2003/0064806) discloses a gaming machine with actuating award indicators.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau  
Primary Patent Examiner  
Art Unit 3714

TH

11/7/07